



AMENDMENT UNDER 37 C.F.R. § 1.116

U.S. Application No. 09/837,487

Attorney Docket No. Q64156

REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 1-6 and 9-13 are now pending in the application, of which Examiner has withdrawn claims 11-13 based on an alleged constructive election. The rejections are respectfully submitted to be obviated in view of the remarks presented herein.

As a preliminary matter, Applicants again respectfully request Examiner to consider the non-patent literature submitted in the IDS filed on November 21, 2002, with which Applicants have also previously provided an English-translation of pertinent portions of the corresponding Japanese Office Action dated September 24, 2002, in compliance with 37 C.F.R. § 1.98(a)(3) (see MPEP § 609 III.A.A(3)). In accordance with § 609 of the MPEP, the Examiner is required to consider any IDS filed which satisfies all of the enumerated provisions, and in the case of information listed that is not in the English language, Applicant is required to provide an English-language translation of relevant portions thereof. Applicants' submission on November 21, 2002 of the IDS and English-translation of pertinent portions of the Japanese Office Action comply with the content requirements for information listed in the IDS, and consideration by the Office of the non-patent literature is again respectfully requested.

Furthermore, Applicants note that Examiner has not indicated on the Office Action Summary PTOL-326 form that all certified copies of the priority documents have been received. Therefore, Applicants respectfully request Examiner to acknowledge in the next office communication and indicate that all certified copies of the priority documents have been received.

Election/Restrictions

The Examiner alleges that claims 11-13 are “directed to an invention that is independent or distinct from the invention originally claimed.” Further, the Examiner has withdrawn claims 11-13 from consideration, alleging that claims 1-6 have been constructively elected by original presentation. Applicants respectfully disagree with this election requirement, and maintain that claims 11-13 are directed to an invention that is *not independent or distinct from the invention originally claimed*, in particular, claims 1-6.

Applicants respectfully submit that the restriction requirement is not proper, as the Examiner has not complied with the basic requirements of making a restriction requirement. First, as indicated in MPEP § 808, when requiring a restriction requirement, the Examiner should: (1) give the reasons why each invention is either independent or distinct from the other; and (2) give the reasons why there would be a serious burden on the examiner if restriction is not required. Although the Examiner has indicated that claims 11-13 would have a separate classification of class 705, subclass 22, the Examiner’s statement is merely conclusory, and no *explanation or reasons* have been given as to why there would be a serious burden on the Examiner if restriction is not required, as is required by MPEP § 808.02. As stated in MPEP § 808, a “mere statement of conclusion” such as that given by the Examiner is not sufficient as providing these reasons.

Applicants believe claims 11-13 to be directed towards similar subject matter as recited in the examined claims 1-6, whereby the Examiner would not be subjected to a serious burden by also examining claims 11-13. Thus, Applicants respectfully request the Examiner to subject

claims 11-13 to an examination, to withdraw this restriction requirement, and to issue a new Office Action considering claims 11-13.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-6 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully submit that the claimed subject matter is described in the specification and also clearly shown in the figures. In particular, claim 1 recites “a communication device for providing a line connection between said audit system and said test object system.” FIG. 1 depicts an exemplary embodiment of such a line connection provided between the audit device (2) and the system for audit (4). The electronic audit system as shown in FIG. 1 depicts, as a line connection between elements of the system, that a communication device (such as the line connection for communication between the elements) is present to provide such a line connection between the claimed audit system and test object system.

Furthermore, the audit system audits the test object system based on “necessary information” sent from the test object system. Such information is clearly described in the specification on at least page 13, lines 2-6, and page 16, lines 13-20, in which support is found for information which is sent from the system being audited (test object system) and which may be necessary in performing the audit.

Also, support is found in the specification for exemplary embodiments of the claimed “identification information transmission device (element 7 of FIG. 1), “audit sequence determination device” (element 12 of FIG. 1), “display device” (element 9 of FIG. 1), and

“judgement device” (element 10 of FIG. 1). Exemplary embodiments of all of these claimed elements are relationally shown in the exemplary embodiment of FIG. 1, and further described in the specification on at least page 6, lines 17-23. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are respectfully requested.

Rejection Under 35 U.S.C. § 103(a) - Jones

Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jones (U.S. Patent Number 5,832,458). The rejection is respectfully traversed.

Regarding claim 1, Applicants’ claimed invention relates to an electronic audit system including an electronic test object system, an electronic audit system and a communication device. The communication device provides a line connection between the audit system and the test object system. The audit system and the test object system connect via the communication device, and the audit system audits the test object system based on necessary information sent from the test object system.

Applicants respectfully submit that the disclosure of Jones does not teach or suggest the claimed invention. Jones discloses a system and method for electronically auditing point-of-sale transactions such as to provide a precise accounting system for coupon redemption that insures that the coupons have been used only in connection with the specific articles for which they were issued (column 3, lines 31-37). Jones’s electronic auditing system is disposed in each retail store for monitoring the point-of-sale system in a substantially totally passive manner and for collecting a copy of each retail sales transaction on the point-of-sale system by using a sensor assembly for detecting the processed retail sales transactions (column 4, lines 18-32). The

electronic auditing system does not require any responsive operation by the point-of-sale system and also does not require any modification of the point-of-sale system (column 4, lines 32-37).

However, there is no teaching or suggestion in Jones that “said audit system and said test object system connect via said communications device, and said audit system audits said test object system based on necessary information sent from said test object system,” as recited in claim 1. Jones’s in-store electronic audit system (40) disposed in each retail store (10) as shown in FIG. 1 collects, processes and stores on a real-time basis retail sales transaction data in a totally passive or non-invasive manner with respect to the on-going operations of retail store (10) (column 5, lines 37-42). No active participation of in-store ISP computer (20) is required (column 5, lines 43-45). Periodically, each electronic audit system (40) transmits the retail sales transaction data it has collected through a bidirectional communications network (50) to an audit system central processor (60) for further processing and use by manufacturers and retailers (column 5, lines 47-51). Therefore, *necessary information* is not sent from the test object system, but rather from the audit system (40) itself to the audit system central processor (60) over the communications network (50). Thus, Jones fails to teach or suggest the communications network (50) providing a line connection between the electronic audit system (40) and the ISP computer (20), because as shown in FIG. 2, the communications network (50) only connects the audit system central processor (60) with the audit system (40) and **does not connect with** the ISP computer (20).

Additionally, Jones also fails to teach or suggest any “audit system [which] audits said test object system based on necessary information sent from said test object system,” as claimed.

Because Jones's electronic audit system (40) collects data in a totally passive and non-invasive manner, Jones does not teach or suggest a test object system which sends necessary information by which an audit system audits the test object system. Each electronic audit system (40) only continuously monitors, detects, interprets, processes and stores data from its retail store under the control of an operating program stored in electronic audit system (40) (column 6, lines 12-22). Each electronic audit system (40) is connected by a sensor assembly (100) to a conventional store data and control loop (170) in a substantially totally passive or non-invasive manner (column 6, lines 35-42). The sensor assembly (100) is disposed adjacent a portion of the store loop (170) to enable the digital signals present in store loop (170) to be detected by the sensor assembly (100) and to be interpreted, locally processed and transmitted by electronic audit system (40) through the communications network (50) to audit system central processor (60) for further processing (column 6, lines 44-52). Because the sensor assembly (100) is substantially totally passive or non-invasive to store loop (170), no information is ever sent from the sensor assembly (100) to store loop (170) (column 7, lines 27-33). Electrical signals present in the store loop (170) and passing between POS scanners/registers (30) and ISP computer (20) are only **passively detected** by the sensor assembly (100), therefore, necessary information **is not sent** from the ISP computer (20) with which information the electronic audit system (40) audits the ISP computer (20), as claimed.

At least by virtue of the aforementioned differences, Applicants' claim 1 distinguishes over Jones. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Regarding claim 2, Applicants' claimed invention relates to an electronic audit system including an electronic test object system, an electronic audit system, a maintenance management device, a configuration transmission device, an identification information transmission device, an audit sequence determination device, an access device, an audit device, a display device and a judgement device.

Examiner has failed to particularly point out where these claimed elements are taught or suggested in Jones. Jones discloses a system and method for electronically auditing point-of-sale transactions as discussed above.

Applicants respectfully submit that the disclosure of Jones does not teach or suggest the claimed invention. Specifically, Jones does not teach or suggest any of: a maintenance management device for maintaining and managing the test object system; a configuration transmission device for transmitting configuration information of the test object system to the audit system; an identification information transmission device for transmitting an ID and a password to the audit system; an audit sequence determination device for determining an audit sequence and creating a sequence chart showing the audit sequence; an access device for accessing the test object system using an ID and a password received via the identification information transmission device; an audit device for auditing the test object system accessed via the access device in accordance with the sequence chart and recording results; a display device for displaying audit results obtained by audit with the audit device; and a judgement device for judging quality of audit results based on the audit results displayed by the display device, as recited in claim 2.

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At least by virtue of the aforementioned differences, Applicants' claim 2 distinguishes over Jones. Applicants' claims 3-6 are dependent claims including all of the elements of independent claim 2, which, as established above, distinguishes over Jones. Therefore, claims 3-6 are patentable over Jones for at least the aforementioned reasons as well as for their additionally recited features.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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AMENDMENTS TO THE DRAWINGS

The attached replacement sheets of drawings includes amendments to FIGS. 1 and 12 to correct labeling and typographical errors. The reference number for the --AUDIT ID AND PASSWORD TRANSMISSION DEVICE-- of FIG. 1 has been changed from "8" to --7--. Further, the typographical error "IAUDIT" in element (6) of FIG. 12 has been corrected and replaced with --AUDIT--.

Attachment: Two Replacement Sheets (FIGS. 1 and 12)